

Remarks:

Applicants have studied the Office Action dated May 1, 2007, and has amended the claims to distinctively claim the subject matter of the invention. By virtue of this amendment, claim 35 is amended. No new matter has been added. Support for the claims and the amendments are found within the specification and the drawings. It is submitted that the application, as amended, is in condition for allowance. Reconsideration and reexamination are respectfully requested.

Allowable Subject Matter:

The Applicants wish to thank the Examiner for finding claim 42 allowable. Claim 35 has been amended to substantially incorporate the elements of claim 35; therefore, claim 35 and claims 36-41, depending therefrom, are deemed to be in condition for allowance as well.

For the above reason, the 102 grounds of rejection are now moot.

In the following, the Applicants respond to the Examiner's rejection under Section 112 and objections as to introduction of new matter.

Objections re New Matter under 35 USC 132(a):

The Examiner objects to recitation of the following elements in claim 42 as new matter: (1) a toy having a body with body parts growing in dimension, and (2) a toy generating expression under 35 USC 132(a).

It is respectfully noted that “[w]hen new matter is introduced into the specification, the amendment should be objected to under 35 U.S.C. 132 . . . if the new matter has been entered into the claims or affects the scope of the claims, the claims affected should be rejected under 35 U.S.C. 112, first paragraph, because the new matter is not described in the application as originally filed”. (emphasis added).

In the prior response, Applicants did not amend the specification but only the claims. Therefore, the rejection under 35 USC 132(a) is improper and should be withdrawn.

Objections alleging informalities in claim language:

The Examiner contends that the recited elements in claims 35 and 42 are steps of a method claim and appropriate correction is required. Respectfully, the recited elements referred to by the Examiner are not steps of a method but rather “functional language” in an apparatus claim, which are routinely accepted and commonly practiced.

First of all, “[there] is nothing inherently wrong with defining some part of an invention in functional terms. Functional language does not, in and of itself, render a claim improper.” MPEP § 2173.05(g) (citing In re Swinehart, 439 F.2d 210, 169 USPQ 226 (CCPA 1971)). Further, “[a] functional limitation must be evaluated and considered, just like any other limitation of the claim, for what it fairly conveys to a person of ordinary skill in the pertinent art in the context in which it is used. A functional limitation is often used in association with an element, ingredient to define a particular capability or purpose that is served by the recited element, ingredient.” MPEP § 2173.05.

In fact, thousands of patent applications issue each year with similar functional language. Use of similar language is also sanctioned by the patent office in product-by-process claims and Beauregard type claims. The Examiner is requested to provide support for this objection either in case law or statute or otherwise withdraw this objection.

§112 Rejection(s):

The Examiner rejects the pending claims for similar reasons as in the earlier part of the Action, namely because the claims recite (1) a toy having a body with body parts growing in dimension, and (2) a toy generating expression or imitating desire.

The Examiner is reminded that the claim language should be interpreted in light of the specification and common knowledge (i.e., “common sense”) available to person of ordinary skill, otherwise the Application would be an endless construction of common details which are not necessary for the full understanding of the invention (see MPEP 2173.05).

Common sense would allow a person of ordinary skill reading the application as filed to determine that a toy, in general, has a body with body parts. The Examiner would agree that this is nothing out of the ordinary. In fact, to content otherwise, would result in the extra-ordinary as one would not expect a toy not to have a body or a body part, unless the toy is a virtual toy. Referring to the figures and the specification, it is clear that the invention is related to a physical toy, i.e., (learning growing toy mentioned on page 6) that can be *connected* to a computer, and not a virtual toy that appears on a computer screen. Respectfully, it is undeniable that a virtual toy cannot be connected to a computer.

With respect to the physical growth element, one of ordinary skill would understand that a toy can physically grow in size by way of a mechanical instrument incorporated in one of the toy's physical limbs, elements or attributes. The Applicants respectfully submit that the Applicants are not claiming subject matter that is within the realm of science fiction, or in defiance of the laws of physics. As such, the lack of inclusion of such details is not an indication that the specification does not support the claim language.

The Examiner is reminded that §112, first paragraph, requires for the specification to adequately support the subject matter claimed rather than mirroring the claim language word for word. MPEP 2163, Moba, B.V. v. Diamond Automation, Inc., 325 F.3d 1306, 1319, 66 USPQ2d 1429, 1438 (Fed. Cir. 2003); Vas-Cath, Inc. v. Mahurkar, 935 F.2d at 1563, 19 USPQ2d at 1116.

Support can be provided “in a variety of ways” and “using such descriptive means as words, structures, figures, diagrams, and formulas” to “show that the Applicants were in possession of the claimed invention. Lockwood v. American Airlines, Inc., 107 F.3d 1565, 1572, 41 USPQ2d 1961, 1966 (Fed. Cir. 1997). See, e.g., Pfaff v. Wells Elecs., Inc., 525 U.S. 55, 68, 119 S.Ct. 304, 312, 48 USPQ2d 1641, 1647 (1998) (emphasis added). Further, claim limitations may be supported in the specification through “express, implicit, or inherent disclosure.” See In re Oda, 443 F.2d 1200, 170 USPQ 268 (CCPA 1971).

Accordingly, contrary to the Examiner's position, the test under Section 112 is not whether all possible details are included in the specification or the claim, but whether a person of ordinary skill would understand, based on common sense or common knowledge, how the invention works, if he read the specification.

Over the past decades, there have been many examples of toys with moving and growing limbs and parts, or toys that imitate emotion and desire available in the market. As an example of toys that display desire or imitate emotion, talking dolls, or barking plush toys are common in any toy store. As an example of toys that grow in size, any toy with a telescopic arm or leg or other body part would suffice.

On page 4, par. 5 of the Office Action, the Examiner seems to engage in a philosophical discourse about whether what one living organism desires is the same as another organism. Respectfully, the Applicants fail to follow the logic of the argument presented by the Examiner as applicable to the standing rejection under Section 112. Such questions or issues are not relevant, and respectfully even if the Applicants could articulate an intelligent response, it would not really matter in the context of a rejection under Section 112.

Within the context of Section 112, isn't discussing what the desires of a sea creature are and if a bag of chips satisfies the hunger of one person and not another rather absurd? How do these examples apply to supportive language under Section 112?

Further, the Examiner on page 5 contends that "a toy does not actually 'output' a desire" and then suggests that the term "output" to be replaced with "language detailing the simulation of such desires" to make the claim more clear. Respectfully, the term "output" as used in the claims is recited in the following manner: "a first unit outputting information about a first desire." There is nothing vague about the recited language, because as used the operative word to which "output" refers to is "information" not "desire." The term "output" is accordingly used in the proper manner both grammatically and statutorily.

The Applicants respectfully submit that a person of ordinary skill would understand that information associated with emotions of a living organism comprise information about whether the living organism is happy, sad, hungry, excited, friendly, hostile, etc. The claim language should be interpreted in light of the specification and common knowledge (i.e., “common sense”) available to a person of ordinary skill; otherwise, the Application would be an endless construction of common details which are not necessary for the full understanding of the invention (see MPEP 2173.05).

The Examiner is requested to withdraw the 112 rejection or otherwise recite case law or a statute in support of her rejections.

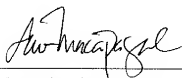
No amendment made was related to the statutory requirements of patentability unless expressly stated herein; and no amendment made was for the purpose of narrowing the scope of any claim, unless Applicants have expressly argued herein that such amendment was made to distinguish over a particular reference or combination of references.

If for any reason the Examiner finds the application other than in condition for allowance, the Examiner is requested to call the undersigned attorney at the Los Angeles, California, telephone number (213) 623 2221 to discuss the steps necessary for placing the application in condition for allowance.

Respectfully submitted,

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